

**REMARKS**

Claims 39-42 and 44-62 are pending in this application. Claims 39-42 and 44-62 have been amended.

**Summary of Telephone Interview on May 2, 2007**

A telephone interview was held on May 2, 2007, between Applicants' attorneys, Richard C. Kim and Merle Richman, and Examiners Mary Hoffman and her SPE, Eduardo C. Robert. Applicants wish to thank Examiners Hoffman and Eduardo for their time and consideration during the interview.

Examiners Hoffman and Eduardo took the position that language such as "configured to be coupled to" constitutes merely functional language that does not serve to differentiate the structural elements of a claim from prior art structures. Mr. Kim did not necessarily agree with this position, however, in the interest of expediting prosecution agreed to amend the claims to eliminate the "configured to be coupled to" language and directly recite "securing members" that are connected to the claimed connection units.

In order to overcome any contemplated restriction requirement rejections, Mr. Kim further agreed to state that the sub-combinations (i.e., "connection units") covered by the previously pending claims are essential to the patentability of the combinations (i.e., "connection systems") as covered by the currently amended claims. Therefore, restriction between the currently amended combination claims and the previously pending sub-combination claims would not be proper under MPEP § 806.06(c). Such a statement per MPEP § 806.06(c) is provided below. The Examiners agreed this type of statement would overcome a restriction requirement rejection.

Examiner Hoffman further stated that she believes at least claim 39 to be anticipated by U.S. 2004/0236327 to Paul et al. More specifically, Examiner Hoffman indicated that the discussion of "transconnectors" in paragraph [0054] of the Paul reference anticipates at least claim 39. Mr. Kim did not agree that this rejection was proper but stated he would further review and

consider the Paul reference and, thereafter, address Examiner Hoffman's rejection in writing in view of any amendments to the claims as presented herein.

Claim Rejections Under 35 U.S.C. § 112

Claims 46-62 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. In particular the Examiner contended that the term "separate" in claims 46 and 52 was not enabled. After amendment claims 46 and 52 do not include this term. Accordingly, Applicants respectfully submit that the Examiner's rejection of claims 46-62 under 35 U.S.C. 112 is moot.

Claim Rejections Under 35 U.S.C. § 102

Claims 39, 40-42, 46-48, and 52-54 were rejected as being anticipated by U.S. Publication No. 2004/0236327 to Paul et al. ("Paul"). In particular, the Examiner stated, "Paul et al. disclose embodiments of a connection unit that can be used as a transconnector (paragraph [0054]), in which the first and second end portions/elements are the fasteners (lines 9-10 of paragraph [0054]) connecting the flexible unit, or transconnector, to the rest of the rod assembly. The spacer/element's (e.g., 262, 121) motion along the direction of the longitudinal member is limited by the fasteners that would secure the spacer to the rod assembly."

As amended, independent claim 39 now positively recites "a first bone securing member," which would correspond to a fastener disclosed by Paul et al. As recited in claim 39, it is clear that the "first bone securing member" is a distinct element from the "first and second end portions," which are not "fasteners" but are part of the rod assembly. Furthermore, in accordance with Applicants' invention, the "first and second end portions" limit motion of the spacer, not the "first bone securing member" (e.g., fastener). This is direct contrast with the device of Paul et al. and Applicants respectfully submit that the functionality of the Applicants' invention is significantly different from that of Paul et al. For example, in the device of Paul et al., the amount of motion of the purported spacer (262, 121) would be dictated by the spacing between "fasteners" connected to the rod. Therefore, the motion of the spacer could vary significantly from one surgery to another

depending on how far apart the fasteners were located from one another. In contrast, in the present invention, the “bone securing members” (e.g., fasteners) are separate elements from the elements of the rod and do not directly contact or limit motion of the spacer. Rather, it is the end portions of the rod itself that limit motion of the spacer. Applicants respectfully submit that this is a significant difference and improvement over the device disclosed by Paul et al.

Similarly, independent claim 46, as amended, now positively recites “a first securing member of a first bone securing assembly” and “a second securing member of a second bone securing assembly,” which would correspond to the “fasteners” taught by Paul et al. Claim 46 further recites that the “first and second elements [of the rod] substantially limit motion of the third element in a longitudinal direction.” It is clear that the “first and second elements” are distinct elements from the “first and second securing members” (e.g., “fasteners”). Thus, in claim 46, the motion of the third element is not limited by fasteners but by elements of the rod assembly itself. As explained above, this is a significant difference and improvement over prior art devices.

Finally, independent claim 52, as amended, also positively recites “a first securing member of a first bone securing assembly” and “a second securing member of a second bone securing assembly,” which would correspond to the “fasteners” taught by Paul et al. Claim 52 further recites that the “the first and third elements substantially limit motion of the second element in a longitudinal direction.” It is clear that the “first and third elements” are distinct elements from the “first and second securing members” (e.g., “fasteners”). Thus, in claim 52, the motion of the second element is not limited by fasteners but by elements of the rod assembly itself, which is very different from the device disclosed by Paul et al.

For at least the above reasons, Applicants respectfully submit that independent claims 39, 46 and 52, as amended, are patentable over Paul et al. Therefore, Applicants respectfully submit that the Examiner’s rejection of claims 39, 46, and 52, and their respective dependent claims, as anticipated by Paul has been overcome.

Claim Rejections Under 35 U.S.C. § 103

Claims 44-45, 49-51, and 55-62 were rejected as obvious over Paul. As discussed above, Applicants have amended independent claims 39, 46 and 52 so that they positively recited at least one “securing member of a [] bone securing assembly,” which would correspond to the fasteners disclosed by Paul et al. It is clear in the amended claims that the elements of the rod are distinct elements from the “securing member[s]”. As explained above, Applicants respectfully submit that this is significant and important difference when compared to the connection system disclosed by Paul et al. For at least these reasons, Applicants respectfully submit that Paul et al. neither anticipates nor renders obvious claims 39, 46 and 52 of the present application for patent. Therefore, claims 44-45, 49-51 and 55-62, which depend from claims 39, 46 and 52, respectively, are also novel and non-obvious in view of Paul et al.

Statement Under MPEP § 806.05(c)

Via this Amendment, Applicants have changed previously pending sub-combination claims directed to a “connection unit” to combination claims directed to a “connection system” that includes a connection unit (i.e., a “rod”) and at least one securing assembly. Previously pending claims which fall within this combination/sub-combination dichotomy were previously restricted in a restriction requirement mailed on March 7, 2006. In a response mailed on May 5, 2006, Applicants elected claims directed to sub-combinations of Applicants’ invention for further prosecution.

However, in order to overcome the Examiner’s current rejections over the prior art and the Examiner’s position that “merely functional language” is insufficient to distinguish over the prior art, Applicants have amended the claims to incorporate further elements which convert the claims into combination claims, similar to previously pending combination claims which were previously canceled without prejudice. Applicants respectfully submit that no restriction is necessary between the previously pending sub-combination and the currently pending combination claims because the combination claims require the details of the sub-combination claims for

purposes of patentability. Therefore, the inventions are not distinct and a requirement for restriction must not be made or maintained. See MPEP § 806.05(c).

As mentioned above, during the telephone interview of May 2, 2007, Examiner Robert agreed that such a statement under MPEP § 806.05(c) would overcome the previous restriction requirement.

**CONCLUSION**

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 559552000100. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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Respectfully submitted,

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